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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/605,946

11/07/2003

Dan T. MUELLER

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HOWREY LLP

C/O IP DOCKETING DEPARTMENT

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EXAMINER

FULLER, BRYAN A

ART UNIT

PAPER NUMBER

3676

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/605,946

**Applicant(s)**

MUELLER, DAN T.

**Examiner**

Bryan A. Fuller

**Art Unit**

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/12/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 and 31-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-30 is/are rejected.
- 7) ☒ Claim(s) 24,25 and 27 is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/5/04 & 7/12/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 - 20, drawn to a cement composition, classified in class 106, subclass 816.
  - II. Claims 21 - 30, drawn to a method of cementing an oil or gas well, classified in class 106, subclass 816.
  - III. Claims 31 - 40, drawn to a method of preparing a cement structure, classified in class 106, subclass 816.
2. The inventions are distinct, each from the other because: Inventions II & III and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used for building or construction material, building blocks, coating (spray on coating on sides of buildings), walkways, roads (can be concrete/cement), tile, swimming pools (another subterranean zone) concrete repair of driveway, or garages.
3. Inventions II and III are independent inventions.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Jeffrey Phillips on 8/04/2005 a provisional election was made with traverse to prosecute the invention of Group II claims 21 - 30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 – 20 and 31 - 40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

6. Claims 24, 25, and 27 are objected to for containing improper MARKUSH groups. This objection can be overcome by replacing the word "is" in claims 24 & 25 and replacing it with the phrase "is selected from the group consisting of." With regard to claim 27 the word "are" with the phrase "are selected from the group consisting of."

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 21 – 26, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Onan et al (5,696,059).

With respect to claims 21 and 22: Onan et al teaches in column 2, line 21 – column 4, line 21 a method of cementing an oil or gas well, the method comprising; providing a cement composition comprising water, cement, and low reactivity particles,

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wherein the particles have a size of about 40 mesh to about 250 mesh; pumping the composition into the well; and allowing the composition to set. The reference inherently possesses the feature of fracturing in a non-linear manner when set.

With respect to claim 23: Onan et al teaches in column 4, lines 12 – 21 a method wherein the water is present at a concentration of about 30 weight percent to about 150 weight percent, based on the weight of the cement.

With respect to claim 24: Onan et al teaches in column 3, lines 37 - 49 a method wherein the cement is API Class A cement, API Class B cement, API Class C cement, API Class G cement, or API Class H cement.

With respect to claim 25: Onan et al teaches in column 3, lines 29 - 36 a method wherein the cement, ASTM cement is ASTM class 11 cement, ASTM class 111 cement, ASTM class IV cement, or ASTM class V cement.

With respect to claim 26 and 29: Onan et al teaches in column 4, lines 1 - 11 a method wherein the particles are silica sand.

9. Claims 21 – 22, 24, 26, 28 – 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Powell (4,090,561).

With respect to claims 21 and 22: Powell teaches in column 1, line 26 – column 3, line 43 a method of cementing an oil or gas well, the method comprising; providing a cement composition comprising water, cement, and low reactivity particles, wherein the particles have a size of about 40 mesh to about 250 mesh; pumping the composition into the well; and allowing the composition to set. The reference inherently possesses the feature of fracturing in a non-linear manner when set.

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With respect to claim 24: Powell teaches in column 2, lines 32 - 34 a method wherein the cement is API Class A cement, API Class B cement, API Class C cement, API Class G cement, or API Class H cement.

With respect to claims 26 and 29: Powell teaches in column 3, lines 28 - 43 a method wherein the particles are silica sand and sand.

With respect to claim 28: Powell teaches in column 3, lines 28 - 43 a method wherein the particles are present at a concentration of about 30 weight percent to about 100 weight percent, based on the weight of the cement.

With respect to claim 30: Powell teaches in column 3, lines 28 - 43 a method wherein the composition further comprises gravel.

10. Claims 21 - 22 and 27 - 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Eilers (4,556,109).

With respect to claims 21 and 22: Eilers teaches in column 2, line 44 - column 3, line 15 a method of cementing an oil or gas well, the method comprising; providing a cement composition comprising water, cement, and low reactivity particles, wherein the particles have a size of about 40 mesh to about 250 mesh; pumping the composition into the well; and allowing the composition to set. The reference inherently possesses the feature of fracturing in a non-linear manner when set.

With respect to claim 27: Eilers teaches in column 3, lines 7 - 15 a method wherein the particles are aluminum silicate, gilsonite, ground coal, adamantane, or fullerene.

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With respect to claim 28: Eilers teaches in column 3, lines 44 - 51 a method wherein the particles are present at a concentration of about 30 weight percent to about 100 weight percent, based on the weight of the cement.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan A. Fuller whose telephone number is (571) 272-8119. The examiner can normally be reached on M - Th 7:30 - 5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian E. Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Brian E. Glessner  
Supervisory Patent Examiner  
Art Unit 3676

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